

## **REMARKS**

Claims 1-14 are pending in this application. Applicants have amended claim 1. Applicants believe that no new matter has been added by the amendment contained in this Office Action Response.


### **Response to Information Disclosure Statement**

Applicants have disclosed references known to relate to satellite positioning systems and believe that they provide a general understanding of satellite positioning systems. Applicants believe that their invention is not described or shown in the references. It is noted that the Examiner has cited the Watters patent (US Patent 5,982,324) in a 35 U.S.C. §102 and a 35 U.S.C. §103 rejection in a Non-Final Office Action.

### **Response to 35 U.S.C. §102 Rejection**

#### **The Bloebaum patent application:**

The Examiner rejected claims 1, 3 and 4 under 35 U.S.C. §102(e), as being anticipated by Bloebaum (US Patent Application 09/747,904). The Bloebaum Patent Application, in paragraph 7 describes; "The mobile terminal determines whether a position estimate satisfying the desired quality of service can be provided with aiding data currently stored in its memory." Thus, aiding data is always used in determining the location of the mobile. The Bloebaum Patent Application just makes a determination to use aiding data currently stored in memory or acquiring aiding data from a remote source. Applicants, in amended independent claim 1, claim; "a communication system, coupled to the GPS section and the call processing section, for selectively transmitting first data to the GPS terminal from the location aiding server and receiving data from the GPS terminal to be sent to the location aiding server, based on the first message and the second



message if the QoS response message indicates that first data is required by the GPS section in order to provide a predetermined QoS, otherwise no location aiding data is employed.” Thus, the Bloebaum Patent Application fails to describe or teach using aiding data when the QoS can not otherwise be obtained. Therefore, Applicants respectfully submit that independent claim 1 and claims 2-14 that depend from independent claim 1 are in condition for allowance.

*Tsujimoto Patent Application:*

The Examiner rejected claims 1-14 under 35 U.S.C. §102(e), as being anticipated by Tsujimoto (US Patent Application 09/828,066). Applicants directs the Examiner’s attention to the filing date of the Tsujimoto Patent Application. The filing date of the Tsujimoto Patent Application is April 5, 2001. Applicants’ application was filed on February 21, 2002 and claimed priority to United States Provisional Patent Application No. 60/270,682 filed on February 21, 2001. Further, the Examiner acknowledged the claim for domestic priority for Applicants’ application under 35 U.S.C. §119(e) in Paper No. 5. Therefore, the Tsujimoto Patent Application is not prior art under 35 U.S.C. §102(e) because it has a filing date after Applicants’ application. Thus, Applicants submit that claims 1-14 are in condition for allowance.

*Watters Patent:*

The Examiner rejected claims 1, 3-6 and 10-12 under 35 U.S.C. §102(e), as being anticipated by Watters (US Patent 5,982,324). The Examiner states that at column 20, lines 44 to column 21, lines 18 describe elements of Applicants’ claim 1. Column 20, lines 44 to column 21, lines 18 recite:



“Thereafter, as long as the requisite number of GPS satellites are in view of GPS receiver portion 1005, the GPS receiver portion continues to calculate position in this manner. Thus, in block 1110, the GPS receiver portion 1005 determines whether the requisite number of GPS satellites are in view. If the requisite number of GPS satellites are in view (i.e., the answer to the inquiry is yes”), then at block 1115, the GPS receiver portion 1005 again calculates (or simply updates) the position of the mobile terminal using GPS. This process is generally repeated every second or few seconds. Of course, the time between successive calculations can be set to any desired amount. In addition, at block 1115, the time offset of transmission of the periodic signals from each base station may be recalculated and updated, and stored in the cellular position processor 1025 or the central processor 1015. Then, the next step will be at block 1110, where the same inquiry as to the requisite number of GPS satellites being in view is made.

However, if the answer to the inquiry at block 1110 is “no,” that is, the number of visible GPS satellites has dropped below the requisite level (usually four), then the position determination for the mobile terminal 1000 is switched over to the cellular position processor 1025. This is shown at block 1120. The switching over may be carried out by the central processor 1015. In addition, the information of the last known position of the mobile terminal 1000 and each of the base stations 1030, 1035, and 1040, along with the time offset of transmission of the periodic signal from the base stations, is made available to cellular position processor 1025 if it does not already have the information. The cellular position processor 1025 calculates position using the periodic signals from the base stations, as described below.”

Thus, the Watters patent teaches and describes an inquiry (block 1110) by the GPS receiver portion 1005 that determines whether the requisite number of GPS satellites are in view. If the requisite number of GPS satellites are in view, then at block 1115, the GPS receiver portion 1005 again calculates (or simply updates) the position of the mobile terminal using GPS. If the requisite number of the GPS satellites are not in view then the position determination for the mobile terminal 1000 is switched over to the cellular position processor 1025. Thus, the GPS

receiver determines when the mobile terminal 1000 is switched over to the cellular position processor.

Applicants, in independent claim 1, claim; “a first message being passed from the call processing section to the GPS section via the interface, and a second message is passed via the interface from the GPS section to the call processing section in response thereto, wherein the first message is a Quality of Service (QoS) message and the second message is a QoS response message....” Therefore, a first message is passed from the call processing section to the GPS section. This is opposed to the teachings and descriptions contained in the Watters patent of the GPS receiver portion determining when to switch over to the cellular position process.

Thus, the Watters patent fails to teach or describe all the elements of amended independent claim 1 and it is in condition for allowance. Further, claims 3-6 and 10-12 that depend from allowable independent claim 1 are also in condition for allowance.

### **Response to 35 U.S.C § 103 Rejections**

#### **Bloebaum in view of Krasner:**

Claim 2 depends from allowable independent claim 1 and thus is in condition for allowance.

#### **Watters in view of Biacs:**

Claim 2 depends from allowable independent claim 1 and thus is in condition for allowance.

**Response to Double Patenting Rejection**

**U.S. Patent 6,462,708:**

The Examiner rejected claims 1-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over patent claim 19 of US 6,426,708 (hereafter the '708 patent). The Examiner states that the "[p]resent Application claim 1 is essentially the same as patent claim 19, where that Patent's "strategy selector" (column 10, line 1) is equivalent to the Present Application's "call processing section" and the Patent's "GPS section and the strategy selector pass information between the GPS section and the strategy selector" (column 12, lines 15-17) is equivalent to the Present Application's exchanging a first message and second message." Applicants point out that the '708 patent requires elements of a GPS section, a strategy selector, and a communication system. If the strategy selector is the same as the call processing section, than what is the communication system in the '708 patent. The strategy selector is a separate element from the communication system and should not be interpreted in a way that results in the elimination of an element. Applicants submit that the call processing section can not be interpreted as being a strategy selector and a communication system as claimed in the '708 patent. Thus, the claims of the '708 patent are distinct and require different elements than the present application.

**Copending Application No. 10/213,767:**

The Examiner provisionally rejected claims 1-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Copending Application claim 39 of Copending Application No. 10/213,767. The filing date of the present application is February 21, 2002. The filing date of the copending application is August 7, 2002. The provisional


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rejection is improper in this case because the later application (i.e. the copending application) should be rejected, not the earlier application. Otherwise, Applicants would submit a terminal disclaimer to overcome the double patenting in the present case and would be adding months to the patent term (which is impossible) rather than disclaiming months.

**Conclusion**

In view of the foregoing discussion and amendments, Applicants respectfully submit that claims 1-14 as presented are in a condition for allowance, which action is earnestly solicited.

Respectfully submitted,  
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